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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212917
Party	Plaintiff Primal Wear, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

PRIMAL WEAR, INC.)	
)	
)	
v.)	Opposition No. 91212917
)	
LB BRANDS, LLC,)	Serial No. 85/689,425
)	
Applicant.)	Opposed Mark: IT STIRS YOUR PRIMAL SENSES
)	

**OPPOSER’S REPLY TO APPLICANT’S MOTION
TO SUSPEND FOR SETTLEMENT DISCUSSIONS**

Primal Wear, Inc., a Colorado corporation (“Primal Wear” or “Opposer”), by and through its undersigned attorney, hereby opposes Applicant’s Motion Suspend for Settlement Discussions (“Motion to Suspend”). Primal Wear’s opposition to the Motion to Suspend is based on its desire to move forward with the matter at hand and further supported by the following facts:

1) Applicant has submitted the Motion to Suspend as a consented document; however, this is incorrectly classified, as Opposer has never consented to any additional extensions of time. While the parties have intermittently discussed settlement, they have been unable to reach a conclusion that is satisfactory to both parties. Opposer has never indicated that it was in agreement with the idea of suspending or extending the proceedings to allow Applicant additional time to formulate an acceptable settlement offer or to save Applicant the costs of responding to discovery or summary judgment.

2) Similar to the facts and analysis detailed in Opposer’s Motion for Summary Judgment and Reply to Applicant’s Motion to Extend Time to Respond to Opposer’s Written Discovery (the “Motion for Summary Judgment”), Applicant has once again failed to follow the established rules governing discovery and motions practice. It first failed to timely respond to Opposer’s discovery, therefore admitting every fact necessary to prove that its registration and use of the mark IT STIRS YOUR PRIMAL SENSES is likely to cause confusion with the long-used, federally-registered PRIMAL marks of Opposer, and now has failed to timely respond to the Motion for Summary Judgment, and failed to file a Motion to Reopen Time.

ARGUMENT

Applicant had a variety of options open to it, if it wished to suspend the proceedings, deny its admissions, or re-open time to respond to the Motion for Summary Judgment. Because it has done none of these things, and instead disregarded the established rules of practice, its motion should be denied, Opposer's previous Motion for Summary Judgment should be granted, and Applicant's trademark application should not be allowed to proceed to registration due to its confusing similarity to Opposer's mark.

1) **Suspension of Proceedings.** As discussed in the Motion for Summary Judgment, Applicant has again sought to suspend the proceedings so it will not be inconvenienced or incur legal fees. Instead, it has chosen to periodically communicate regarding settlement while essentially ignoring the TTAB proceeding and deadlines. The parties have indeed been in settlement discussions, but Opposer has indicated on several occasions that if the parties were not able to reach settlement (in the most recent instance/version of the proposed settlement agreement, by April 4, 2014), then they should resume the TTAB proceeding. "A party which fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk, and should not expect that such relief will be granted retroactively, particularly - as here - over the opposing party's objection." Old Nutfield Brewing Company, Ltd. v. Hudson Valley Brewing Company, Inc., 65 U.S.P.Q.2D (BNA) 1701 (TTAB 2002)

Mere laziness, expenditure of time or expense does not relieve a party of its obligation to timely respond to discovery requests. Metpath, Inc. v. Modern Medicine, 1991 U.S. App. LEXIS 10796, 8 (4th Cir. 1991); see also Atlanta-Fulton County Zoo Inc. v. De Palma, 45 USPQ2d 1858, 8-9 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay); Luemme, Inc. v. D.B. Plus Inc., 53 USPQ2d 1758, 1760, 1761 (TTAB 1999) (noting that "Neither the Board nor respondent will sit idle for the convenience" of a party who failed to set forth detailed facts concerning the allegedly busy travel schedule which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously set discovery period). Proceedings are not suspended automatically when parties are discussing settlement. Old Nutfield, 65 USPQ2d 1701 (TTAB 2002). A party which fails to timely move for extension or suspension of dates on the basis of settlement does so at its own risk. Id.

2) **Request for Admissions.** Viewing Applicant's motion in the light most favorable to it would imply that its attempted suspension of proceedings could also be viewed as an attempt to withdraw or amend the admissions it conceded by failing to answer in a timely manner.¹ Courts have substantial discretion in deciding whether to allow withdrawal of an admission. Giersch v. Scripps Networks, Inc., 85 USPQ2d 1306 (TTAB 2007). There is a two-prong test for allowing withdrawal or amendment of admissions: The presentation of the merits of the action will be subverted thereby, and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action on the merits. Giersch, 85 USPQ2d at 1308. However, when a party fails to avail itself of the appropriate options, the Request for Admissions are properly established. Armor All/STP Prod. Co. v. Ltd. Liab. Co. "Autoplastic", LEXIS 585, 11 (TTAB 2013) (granting summary judgment in a cancellation proceeding where respondent failed to answer or object to Requests for Admissions, nor did it file a motion to withdraw or amend its admissions pursuant to Fed. R. Civ. P. 36(b)).

In the matter at hand, Applicant could have moved to withdraw its admissions under TBMP Section 525, which would allow her to either move to reopen its time to serve responses to the outstanding admission requests because its failure to timely respond was the result of excusable neglect under Fed. R. Civ. P. 6(b)(1)(B), or move to withdraw and amend its admissions pursuant to Fed. R. Civ. P. 36(b). Here, applicant, in its brief in response to Motion to Suspend for Settlement Discussions, does not assert that its failure to timely respond was the result of excusable neglect, nor has it moved to withdraw and amend its admissions. Rather, it has simply stated that the parties are in settlement discussions, and it does not wish to incur the costs of responding to summary judgment in the event the parties can settle the matter.

3) **Re-Opening Time.** Again viewing Applicant's motion in the light most favorable to it, we can classify its motion as an attempt to re-open time to respond to the Motion for Summary Judgment. Trademark Rule 509.01(b)(1) provides that "[w]here the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action." Even then, "a party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient. The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in Pioneer Investment Services Company v. Brunswick

¹ Note that the parties agreed to serve and respond to discovery via electronic means.

Associates Ltd. Partnership, 507 U.S. 380 (1993), adopted by the Board in Pumpkin Ltd. v. The Seed Corps, 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. It has been held that the third Pioneer factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," maybe deemed to be the most important of the Pioneer factors in a particular case. FirstHealth of the Carolinas, Inc. v. CareFirst of Md., Inc., 479 F.3d 825, 829, (Fed. Cir. 2007).

The Board's interest in deterring delay due to "sloppy practice or inattention to deadlines . . . weighs heavily against a finding of excusable neglect." Id. at 829. A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient. Pumpkin Ltd. v. The Seed Corps, 43 USPQ2d 1582, 1586 n.7 (TTAB 1997). *See also* Giersch v. Scripps Networks Inc., 85 USPQ2d 1306, 1307-1308 (TTAB 2007) (respondent's mistaken belief that counsel for petitioner would agree to an extension request did not relieve respondent of its duty to adhere to appropriate deadlines). Here, Applicant clearly is in receipt of all discovery and motions, but has not been inclined to play by the rules established to keep the matters flowing smoothly through the Trademark Trial and Appeal Board.

CONCLUSION

Opposer respectfully requests that the Trademark Trial and Appeal Board deny Applicant's Motion To Suspend for Settlement Discussions and submits that this opposition against Application Serial No. 85/689,425 must be sustained pursuant to this Motion as a trial on the matter would entail unnecessary fees and a continued waste of the Board's scarce resources, and prays that judgment for Opposer be entered in this proceeding.

Respectfully Submitted on April 9, 2014

Tamara Pester~original signature on file
Tamara Pester, LLC
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ATTORNEY FOR PRIMAL WEAR, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy **OPPOSER'S REPLY TO APPLICANT'S MOTION TO SUSPEND FOR SETTLEMENT DISCUSSIONS** was served via email with a copy via U.S. Mail this April 9, 2014 to:

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